

REMARKS

The objection to claims 1-9 as containing non-elected subject matter is respectfully traversed. On March 3, 2009, the Examiner issued a restriction requirement between the invention of Group I, wherein R1 and R3 are both non-heterocyclic groups, Group II wherein R1 and R3 contain a heterocycle, and Group III relating to method claims 11-25, and stated that applicants had to elect a single compound as the elected species for initial search purposes. In the response filed April 3, 2009, applicants acknowledged the restriction as to the Group II claims, withdrew the method claims, and traversed the restriction as to groups I and II. Applicants also elected for purposes of examination the compound of Example 228, 3-benzoyl-7-(2,6-difluorophenyl)-2-[(1-methylazetidin-3-yl)amino]thieno[2,3-b]pyridine-6(7H)-one.

In the Office Action of June 12, 2009, the Examiner maintained the restriction as to Group I and Group II, and stated that

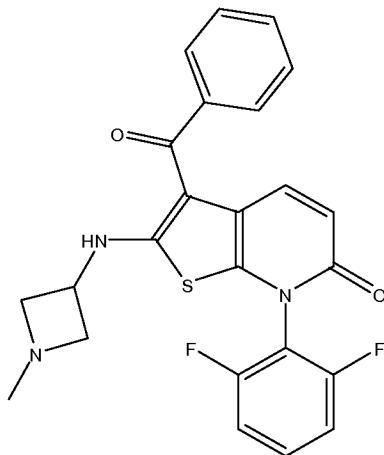
This application has been examined to the extent readable and [the examination has been] expanded to include compounds wherein R¹ is (C₃₋₇cycloalkyl) methyl or aryl, R² represents -CONR^bR^c, -NR^bR^c, -NR^dCONR^bR^c wherein R^b and R^c when taken together with the nitrogen atom to which they are attached, represent (optionally substituted azetidine, pyrrolidine, or piperidene, R³ represents (optionally substituted) aryl, and R^d as set forth in claim 1, exclusively. All additional heteroaryls and heterocycles pertain to nonelected subject matter.

In response applicants amended the claims to delete “heteroaryl” from R¹ and R³. The applicants also responded to the rejections under 35 USC 112. No prior art was cited against the claims. The rejection under 35 USC 112 was subsequently withdrawn.

Although no 112 or prior art rejections remain, the Examiner is now requiring that all subject matter not within R² as stated above be withdrawn from the claims. This requirement is traversed herein for two reasons: 1) the quoted statement with respect to R² above is an incorrect description of the elected species, and 2) the requirement is inconsistent with MPEP 803.02.

1. The Elected Species

The elected species in this case has the structure



R^2 , the group extending from the five-membered ring, is of the formula NR^bR^c , where R^b is C_{3-7} -heterocycloalkyl and R^c is hydrogen. Contrary to the statement in the Office Action of June 12, 2009, this is not the species wherein R^b and R^c together form a ring; instead, R^b itself comprises a ring. The restricted scope of R^2 as stated in the prior action does not encompass the elected species; therefore the requirement for cancellation of subject matter not within the stated restricted scope is improper.

2. The Requirement is contrary to MPEP 803.02

As no art has been cited against the elected species, the MPEP requires that examination of the Markush-type claim be extended:

In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits....Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration....On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended....Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The examination will be extended to the extent necessary to determine patentability of the Markush-type claim.

MPEP 803.02. As no art has been cited against the elected species, the examination must be extended beyond the scope of the provisionally elected subject matter as identified in the Office Action of June 12, 2009 “to the extent necessary to determine the patentability of the Markush-

type claim.” (It is improper to limit the search based on 112 rejections alone.) In this case, by requiring cancellation of subject matter that had been *provisionally* withdrawn only for initial search purposes and without applying prior art against the claims, the examiner is denying the applicant the search to which the applicant is entitled.

The applicant respectfully submits that pursuant to MPEP 803.02, the Office must withdraw the final rejection and search the claims to the scope permitted by the art, up to the full scope of the claims. Should additional prior art be identified, a further non-final action would be appropriate to permit the applicants an opportunity to further amend the claims and/or argue in favor of patentability. As long as the prior art rejections are overcome, the search should be expanded, consistent with the example provided in MPEP 803.02.

Applicants respectfully advise the Examiner that applicants are filing concurrently herewith a Petition Under 37 CFR 1.181 to Withdraw Final Rejection, setting forth substantially the same arguments as made herein with regard to the scope of examination of moiety R².

CONCLUSION

As the grounds of rejection based on the cited art have been overcome, the final rejection should be withdrawn and the search should be expanded to cover that subject matter within the elected Group I which has not yet been examined. If no relevant prior art is found, then a Notice of Allowance is requested. If there are any questions or comments regarding this Response and Amendment, the Examiner is encouraged to contact the undersigned as indicated below.

Respectfully submitted,

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